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10/539,509	12/07/2005	Klaus Schultes	272983US0PCT	4808
22850	7590	04/21/2009	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			LE, HOA T	
			ART UNIT	PAPER NUMBER
			1794	
			NOTIFICATION DATE	DELIVERY MODE
			04/21/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### DETAILED ADVISORY ACTION

1. Applicant's arguments with respect to the anticipatory rejection under 35 USC 102 have been found persuasive. The anticipatory rejection has been withdrawn. However, Applicant's arguments are not persuasive with regard to the obviousness rejection for the reasons discussed below.

2. First ground of obviousness: Applicant contended that "no expressed range in the patent broader than the range 250 to 320 nm." It has been held that "a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. Titanium Metals Corp. of America v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (Court held as proper a rejection of a claim directed to an alloy of "having 0.8% nickel, 0.3% molybdenum, up to 0.1% iron, balance titanium" as obvious over a reference disclosing alloys of 0.75% nickel, 0.25% molybdenum, balance titanium and 0.94% nickel, 0.31% molybdenum, balance titanium.). Here, Fraser teaches a "preferred range" of up to 360 nm as the particle diameter range which is close enough to the claimed radius of "above 160 nm" that one skilled in the art would have expected the claimed product and that of the reference to have same properties. Additionally, Applicant has not stated whether the particle radius as claimed is for any particular purpose or to solve any specific problem. The burden is on Applicant to show that the claimed particle radius results in unexpected properties for the claimed product.

3. Second ground of obviousness: Moreover, it has been held that "where general conditions of a claim are disclosed in the prior art, it is not inventive to discover the

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optimum or workable ranges by routine experimentation.” In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) (Claimed process which was performed at a temperature between 40°C and 80°C and an acid concentration between 25% and 70% was held to be prima facie obvious over a reference process which differed from the claims only in that the reference). Here, Fraser reports a “preferred range” for the diameter of the core-shell particles to be up to 320 nm (i.e. 160nm). Therefore, it would have been obvious to one of ordinary skill in the art to produce core-shell particles having a radius of over or under 160 nm depending on the end-use of the particles through routine experimentation.

4. Unobviousness not established in the instant specification: Applicants further argued that “unobviousness is established in the record on the basis of the improved low temperature impact resistance of the claimed particles as is clear from data in the specification.” The examples (B1, B2 and B3) and comparable examples (VB1 and VB2) fail to serve this argument of Applicant because the core-shell particles in comparative examples VB1 and VB2 exhibit particle radius of 190 nm and 168 nm, respectively, which radii are well within the claimed range of “above 160.0 to 240.0 nm”. In fact, the particle radius of core-shell particle in example B1 and that of comparative example VB1 are both 190 nm, which presents evidence contrary to Applicant’s assertion; that is, the difference in impact resistance between the two core-shell particles is NOT a result of the particle radius difference between the core-shell particles.

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to H. (Holly) T. Le whose telephone number is 571-272-1511. The examiner can normally be reached on 12:30 a.m. to 9:00 p.m. (EST), Mondays to Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. (Holly) T. Le/  
Primary Examiner, Art Unit 1794

April 16, 2009